

## **REMARKS**

### **INTRODUCTION**

With this Amendment, claims 1 and 2 are amended, and new claims 14 and 15 are added, and remarks are provided. Therefore, claims 1-4 and 14-15 are pending and under consideration.

New claims 14 and 15 are supported by the description in paragraphs such as the one on page 16, lines 12-19 of the originally filed application, and by FIG. 5 of the application. No new matter has been added.

### **CLAIM REJECTIONS UNDER 35 U.S.C. §103(a)**

#### **(A) Claims 1 and 3**

Claims 1 and 3 are rejected under 35 U.S.C. §103(a) as being unpatentable over Otomo (JP 2000-011448) ("**Otomo**") in view of Ota (JP 2000-030302) ("**Ota**"). Applicants respectfully disagree with the Examiner for the following reasons.

The Office Action incorrectly interprets the teachings in **Ota**. Regarding FIG. 1 of **Ota**, the Office Action has treated the "protective" layer (layer 5) incorrectly as the "substrate" layer in several occasions (see Office Action mailed May 12, 2008, page 8, lines 8-10, and Office Action mailed March 6, 2009, page 4, lines 2-7). Probably as a result, the "protective" layer (layer 5) in **Ota** is regarded incorrectly to correspond to the Applicants' "substrate" layer. This language error appears to be the cause of confusion in the conclusion of the Office Action.

Applicants would like to point out that, in FIGS. 1 and 2 of **Ota**, "layer 2" is the substrate layer, "layer 3" is the recording layer, "layer 4" is the reflecting layer, "layer 5" is the protective layer, and "layer 6" is the release layer. It is clear that, **Ota** teaches a substrate layer (layer 2), a recording layer (layer 3), a protective layer (layer 5) and a release layer (layer 6). However, these layers in **Ota** are arranged completely differently and non-obviously with respect to the layers in amended claim 1 and claim 3 of the application. Specifically, in **Ota**, the recording layer (layer 3) is directly next to the substrate layer (layer 2), but the release layer (layer 6) is between the recording layer (layer 3) and the reflecting layer (layer 4). In contrast, amended claim 1 recites "a release layer provided between the substrate and the recording layer."

Therefore, applicants maintain the argument that **Ota** does not teach or suggest that a

release layer (layer 6) can be between the substrate layer (layer 2) and the recording layer (layer 3). One having ordinary skill in the art would not have been able to arrive at the invention according to amended claim 1 of the application by the teachings in **Ota** and **Otomo** because **Ota** does not teach or suggest the location of the release layer (layer 6) and cannot remedy the deficiency of **Otomo** as a teaching for the invention in amended claim 1. Although the Examiner has concluded that one of ordinary skill in the art would understand that the “substrate 5” (which is incorrectly assumed) and the “recording layer 3” would be on separate stacks. However, due to the error with the understanding of **Ota**, only the “protective layer” (layer 5) and the “recording layer” (layer 3) would be separated according to **Ota**. According to such logic, the recording layer and the substrate layer are not separated.

Also, with this Amendment, amended claim 1 no longer uses the open “comprising” language but the “consisting essentially” language. As a result, the teaching of **Ota** in using a “peeling operation hole” (component 7) and an “instrument” (component 8) are now outside of the recitation of amended claim 1 and claim 3.

Therefore, the invention according to amended claim 1 and claim 3 are not obvious over **Otomo** and **Ota**, individually or in combination.

(B) Claims 2 and 4

Claims 2 and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over **Otomo** (JP 2000-011448) (“**Otomo**”) in view of **Matsuishi** (5,972,457) (“**Matsuishi**”) and **Ota** (JP 2000-030302) (“**Ota**”). Applicants respectfully disagree with the Examiner for the following reasons.

The Examiner admits that the combination of **Otomo** and **Matsuishi** does not render claims 2 and 4 obvious “due to the inclusion of the release layer” (Office Action mailed March 6, 2009, page 4, lines 15-16). However, the Examiner concludes that it would be proper to combine **Otomo** and **Matsuishi** because **Matsuishi** also teaches a printing layer. Applicants emphasize that even if **Otomo** and **Matsuishi** are allowed to be combined, such a combination cannot be combined with the teachings of **Ota**.

Amended claim 2 recites, among other features, “a release layer provided between the substrate and the printing layer.” Also, with this Amendment, amended claim 2 no longer uses the open “comprising” language but the “consisting essentially” language. As a result, the teaching of **Ota** in using a “peeling operation hole” (component 7) and an “instrument” (component 8) are now outside of the recitation of amended claim 2 and claim 4.

In contrast, **Ota** only teaches a release layer (layer 6) to be “between” a protecting layer (layer 5) and a reflecting layer (layer 4) on one side, and a recording layer (layer 3) and a substrate layer (layer 2) on the other side. **Ota** does not teach or suggest how a release layer (layer 6) should be located with respect to a substrate and a printing layer. **Ota** does not disclose or teach a printing layer.

The Examiner's conclusion that “the inclusion of a release layer in between any two layers in the optical recording medium of **Otomo** would be *prima facie* obvious because the inclusion of multiple release layers is a mere duplication of parts” is without support. The conclusion is based on impermissible hindsight. When **Otomo** and **Matsuishi** both do not teach any release layer, and when **Ota** does not teach any printing layer, the combination of **Otomo**, **Matsuishi** and **Ota** would not have prompted one having ordinary skill in the art to arrive at the invention according to amended claim 2 with regard to the location of the release layer being between the printing layer and the substrate.

Therefore, the invention according to amended claim 2 and claim 4 would not have been obvious over **Otomo**, **Matsuishi** and **Ota**, individually or in combination.

**CONCLUSION**

In light of the above amendments and remarks, it is respectfully submitted that claims 1-4 and 14-15 are now in condition for allowance.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: March 17, 2009

By: David K. Ho  
David K. Ho  
Registration No. 53,025

1201 New York Ave, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501